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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,635	09/15/2003	Sanjay Agraharam	Cont. of 10/127,070	9757
26652	7590	08/13/2004	EXAMINER	ESCALANTE, OVIDIO
AT&T CORP. P.O. BOX 4110 MIDDLETOWN, NJ 07748			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/662,635	AGRAHAM ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Ovidio Escalante	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 September 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

1. Applicant is advised that should claim 8 be found allowable, claim 9 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 5-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,6-9,11-13 of U.S. Patent No. 6,654,448. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the Application are broader than the claims in US Patent 6,654,448.

For example, claim 1 of the application is the same as claim 1 of the patent except claim 1 of the application does not require the use of restricted domain speech software that is activated based upon input from a user.

Claim 5 of the application also corresponds to claim 6 of the Patent.

Claim 6 of the application also corresponds to claim 7 of the Patent.

Claim 7 of the application also corresponds to claim 8 of the Patent.

Claim 8 of the application also corresponds to claim 9 of the Patent.

Claim 9 of the application also corresponds to claim 9 of the Patent.

Claim 10 of the application also corresponds to claim 11 of the Patent.

Claim 11 of the application also corresponds to claim 12 of the Patent.

Claim 12 of the application also corresponds to claim 13 of the Patent.

***Information Disclosure Statement***

4. The information disclosure statement submitted on September 15, 2003 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 5,6,8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan US Patent 6,072,862 in view of Ibuka et al. US Patent 6,058,164 .

*Regarding claim 1*, Srinivasan teaches a method for transmitting a message (voice message) to an intended recipient (26), (fig. 1; col. 1, lines 5-19), the method comprising:

receiving an oral (voice) message for an intended recipient (26) from a sending party (12), (col. 3, lines 10-11);

converting the oral message into a text message using speech recognition software, (col. 3, line 55-col. 4, line 7); and

transmitting the text message to the intended recipient, (col. 4, lines 23-26; col. 6, lines 25-27).

Srinivasan does not specifically teach of determining that the recipient has a full voice mailbox and in response to said determination, converting the voice message to a text message.

In the same field of endeavor, Ibuka teaches that it was well known in the art to determine that determining whether a voice mail box associated with the intended recipient is full, (col. 47, lines 2-13,23-31); and if the intended recipient's mail box is full, converting the oral message to a text message, (col. 47, lines 55-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Srinivasan by using the teaching of converting the receive voice message to a text message when the voice storage is full as taught by Ibuka so that the storage capacity of the voice memory can be used more efficiently and so that the message recipient can receive all messages even if there is no more space to store the message in the voice message device.

***Regarding claim 2***, Srinivasan, as applied to claim 1, teaches wherein transmitting the text message further comprises emailing the text message to the recipient, (col. 3, line 55-col. 4, line 7).

***Regarding claim 3***, Srinivasan, as applied to claim 1, teaches wherein transmitting the text message further comprises faxing the text message to the recipient, (col. 3, line 55-col. 4, line 7).

***Regarding claim 5***, Srinivasan, as applied to claim 3, teaches determining a facsimile phone number for the intended recipient by accessing a database, (col. 4, lines 15-33).

***Regarding claim 6***, Srinivasan, as applied to claim 2, teaches determining an e-mail address for the intended recipient by accessing a database, (col. 4, lines 15-33).

***Regarding claims 8 and 9***, Srinivasan, as applied to claim 1, teaches wherein the oral message is received on an integrated services network, (fig. 1; col. 3, lines 4-15).

***Regarding claim 10***, Srinivasan, as applied to claim 1, teaches storing information related to the transmitted text message, (col. 2, lines 55-64).

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bijl et al. US Patent 6,173,259 in view of Ibuka et al. US Patent 6,058,164.

***Regarding claim 13***, Bijl teaches an answering service, (voice mail service; col. 5, lines 16-26; abstract), the answering service performing the steps of: receiving an oral message from a sender for a recipient, (col. 4, lines 47-51; col. 5, lines 16-32);

converting the oral message into a text message, (col. 8, lines 41-44; col. 9, lines 16-30,62-67);

audibly playing the text message to the sender for error correction, (col. 5, line 50-col. 6, line 15);

receiving error correction from the recipient, if any, (col. 6, lines 6-16);

and

transmitting the text message to the recipient, (col. 4, lines 24-34).

Bijl does not specifically teach of determining that the recipient has a full voice mailbox and in response to said determination, converting the voice message to a text message.

In the same field of endeavor, Ibuka teaches that it was well known in the art to determine that determining whether a voice mail box associated with the intended recipient is full, (col. 47, lines 2-13,23-31); and if the intended recipient's mail box is full, converting the oral message to a text message, (col. 47, lines 55-63) and if the recipient voice mail box is not full, delivering the oral message to the recipient voice mail box, (col. 47, lines 2-13,23-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bijl by using the teaching of converting the receive voice message to a text message when the voice storage is full as taught by Ibuka so that the storage capacity of the voice memory can be used more efficiently and so that the message recipient can receive all messages even if there is no more space to store the message in the voice message device.

*Regarding claim 14*, Bijl, teaches wherein converting the oral message into a text message occurs using speech recognition software, (col. 8, lines 42-57; col. 9, lines 16-30,62-67).

*Regarding claim 15*, Bijl, teaches wherein converting the oral message into a text message further comprises:

determining whether words exist in the oral message that may not be contained in a general purpose speech recognition software program, (col. 9, lines 16-25; models are applied based on text subject (words)); and

if words exist in the oral message that are not likely contained in a general purpose speech recognition software program, applying a restricted domain speech recognition program, (col. 9, lines 16-25).

10. Claims 4,7,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan in view of Ibuka and further in view of Cohn et al. US Patent 6,064,723.

*Regarding claim 4*, while Srinivasan in view of Ibuka, as applied to claim 1, teaches of transmitting a text message to the recipient, Srinivasan in view of Ibuka do not specifically teach of sending and instant message.

In the same field of endeavor, Cohn teaches that it was well known in the art to convert an oral message to a text message and to instantaneously transmit the text message to the message recipient, (col. 34, lines 2-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Srinivasan and Ibuka, by instantaneously sending the text message as taught by Cohn so that the message recipient can receive the message promptly.

*Regarding claim 7*, while Srinivasan and Ibuka, as applied to claim 1, teaches of transmitting the text to the intended recipient, Srinivasan and Ibuka do not specifically teach of notifying the sender of the oral message of the status of the message.

In the same field of endeavor, Cohn teaches that it was well known in the art to send notification information which includes status information to the sender of the message, (col. 31, lines 9-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Srinivasan and Ibuka by notifying the message originator of the status of the message as taught by Cohn so that the message sender will know whether or not the message was delivered.

***Regarding claims 11 and 12***, while Srinivasan in view of Ibuka, teaches of having subscribers, Srinivasan in view of Ibuka do not teach of billing either the recipient or the sender.

In the same field of endeavor, Cohn teaches that it was well known the art to bill the intended recipient of the text message and the sender of the oral message, (col. 30, lines 49-52; col. 33, lines 56-63)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Srinivasan in view of Ibuka by billing the message sender or recipient so that the system can receive funds for operating its service to users.

***Conclusion***

11. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ovidio Escalante  
Examiner  
Group 2645  
August 3, 2004

**OVIDIO ESCALANTE  
PATENT EXAMINER**

*Ovidio Escalante*